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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,637	04/02/2004	Paul Lapstun	HYC004US	9558
24011	7590	07/29/2008	EXAMINER	
SILVERBROOK RESEARCH PTY LTD			COLBERT, ELLA	
393 DARLING STREET				
BALMAIN, 2041			ART UNIT	PAPER NUMBER
AUSTRALIA			3696	
			MAIL DATE	DELIVERY MODE
			07/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/815,637	LAPSTUN ET AL.	
	Examiner	Art Unit	
	Ella Colbert	3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 April 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-34 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/12/08</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Claims 1-34 are pending. Claims 1 and 18 have been amended in this communication filed 4/24/08 entered as Response After Non-Final Rejection.
2. The IDS's filed 2/12/08 have been entered and reviewed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,699,528) Hogan in view of (US 5,159,321) Masaki et al, hereafter Masaki.

Claim 1. Hogan discloses, A method of enabling anonymous communication between a user and an application, via interaction of a sensing device with coded data printed on an interactive surface to generate interaction data, the method including the steps, performed in a computer system, of: identifying a first telecommunication address of the user from either an identity of the sensing device received or determined in the computer system or the interaction data generated by the sensing device via said interaction with the printed interactive surface (col. 2, lines 48-53). Masaki discloses the sending device and the interaction data (col. 3, lines 14-col. 4, line 2 and lines 33-43 and col. 5, line 49-col. 6, line 43). The manner in which the claim limitation is recited means that only one or the other limitation need to be present in the reference and not

both claim limitations. Hogan further discloses, associating a temporary telecommunication address with the first telecommunication address (col. 3, line 51-col. 4, line 44); sending the temporary telecommunication address and interaction data to an application (col. 5, lines 16-43); receiving information from the application addressed to said temporary telecommunication address (col. 5, lines 44-61); and forwarding the information from the application to the first telecommunication address (col. 5, line 62-col. 6, line 30).

Claim 18, Hogan and Masaki further disclose, A system for enabling anonymous communication between a user and an application, via a sensing device with coded data printed on an interactive surface to generate interaction data, the system including a computer system configured and programmed as recited in claim 1.

This claim is rejected for the similar rationale as given above for claim 1.

Claims 2-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,699,528) Hogan in view of (US 5,159,321) Masaki et al, hereafter Masaki and further in view of (US 6,330,976) Dymetman et al, hereafter Dymetman.

Claims 2 and 19. Hogan and Masaki failed to disclose, wherein the step of identifying the first telecommunication address includes determining an identity of the sensing device, and identifying the first telecommunication address from the identity. Dymetman discloses, wherein the step of identifying the first telecommunication address includes determining an identity of the sensing device, and identifying the first telecommunication address from the identity (col. 10, line 49-col. 11, line 43).

Claims 3 and 20. Hogan, Masaki and Dymetman failed to disclose, wherein the

interaction data includes a digital signature of the user and the step of identifying the first telecommunication address includes identifying the first telecommunication address recorded for a registered user identified by the digital signature. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a digital signature because this would acknowledge that the person agreed with the terms of the document contents.

Claims 4 and 21. Hogan and Masaki failed to disclose, wherein the computer system includes a first server, and the step of associating is performed at the first server. Dymetman discloses, wherein the computer system includes a first server, and the step of associating is performed at the first server (col. 6, lines 55-65).

Claims 5 and 22. Hogan and Masaki failed to disclose, wherein the first server is a registration server. Dymetman discloses, first server is a registration server (col. 6, lines 55-65). However, Dymetman did not expressly disclose the first server is a registration server. Since Dymetman discloses a server and a network, the first server can be a registration server.

Claims 6 and 23. Hogan and Masaki failed to disclose, wherein the step of sending the temporary telecommunication address is performed by the first server. Dymetman discloses, wherein the step of sending the temporary telecommunication address is performed by the first server (col. 16, lines 31-46).

Claims 7 and 24. Hogan and Masaki failed to disclose, wherein the step of associating is performed by encrypting the first telecommunication address of the user to form the temporary telecommunication address. Dymetman discloses, wherein the step of

associating is performed by encrypting the first telecommunication address of the user to form the temporary telecommunication address (col. 16, lines 47-50).

Claims 8 and 25. Hogan, Masaki and Dymetman failed to disclose, wherein the first telecommunication address of the user is derived from the temporary telecommunication address upon receipt of the first information from the applications server by decrypting the temporary telecommunication address to which the first information was sent. It would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt and decrypt information when information is sent over a telecommunications network for security and privacy of the information.

Claims 9 and 26. Hogan and Masaki failed to disclose, wherein the temporary telecommunication address is provided with a unique identifier. Dymetman disclosed, wherein the temporary telecommunication address is provided with a unique identifier (col. 18, lines 1-29).

Claims 10 and 27. Hogan and Masaki failed to disclose, including the step, performed by the first server, of checking the unique identifier to determine whether the first server can forward the information from the application to the first telecommunication address of the user. Dymetman disclosed, including the step, performed by the first server, of checking the unique identifier to determine whether the first server can forward the information from the application to the first telecommunication address of the user (col. 18, lines 30-55).

Claims 11 and 28. Hogan and Masaki failed to disclose, wherein the association of the temporary telecommunication address with the first telecommunication address of the

user is valid for a limited number of steps of said server forwarding the information from the application to the first telecommunication address of the user. Dymetman disclosed, wherein the association of the temporary telecommunication address with the first telecommunication address of the user is valid for a limited number of steps of said server forwarding the information from the application to the first telecommunication address of the user (col. 17, lines 3-51).

Claims 12, 13, 29, and 30. Hogan and Masaki failed to disclose, wherein the first telecommunication address of the user is selected from one of an email address, a web address, a facsimile number, a telephone number, a pager, a mobile phone number, or a Personal Digital Assistant (PDA) address. Dymetman disclosed, , wherein the first telecommunication address of the user is selected from one of an email address, a web address, a facsimile number, a telephone number, a pager, a mobile phone number, or a Personal Digital Assistant (PDA) address (col. 2, lines 55-65).

Claims 14 and 31. Hogan, Masaki and Dymetman failed to disclose, wherein the temporary telecommunication address has the same form as the telecommunication address of the user. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the same form as the telecommunication address for easier transmission and for security.

Claims 15 and 32. Hogan and Masaki failed to disclose, wherein at least some of the coded data includes an identifier. Dymetman disclosed, wherein at least some of the coded data includes an identifier (col. 1, lines 44-67).

Claims 16, 17, 33, and 34. Hogan, Masaki and Dymetman failed to disclose, wherein the identifier is a unique product item identifier and wherein the unique product item identifier is an electronic product code. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a unique identifier for a product and a unique product item identifier as an electronic product code to be able to know which identifier is for which product and for security purposes.

Response to Arguments

Applicants' arguments filed 04/24/08 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: It is respectfully submitted that the subject matter of amended independent claims 1 and 18, and claims 2-17 and 19-34 depend therefrom, is not disclosed or suggested by Hogan either taken alone or in combination with Dymetman, for one of ordinary skill in the art to incorporate a sensing device for interacting with printed interactive surfaces, as required by the claimed invention has been considered but is not persuasive. Response: Applicants' appear to be arguing their amendments to claims 1 and 18 thus making the arguments moot. However, it is interpreted that Hogan discloses a method and a system for enabling an anonymous communication between a user and an application by identifying a first telecommunication address of the user from either an identity of the sensing device. However, Hogan fails to disclose the newly added amendment to claim 1 reciting "the interaction data generated by a sensing device via said interaction with the printed interactive surface. Masaki discloses this as rejected above in claim 1. It would have

been obvious to one of ordinary skill in the art to include the billing system of Hogan with the ability to have the interaction data generated by a sensing device via said interaction with the printed interactive surface as taught by Masaki since the claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Resort can be had to case law for combining references as follows: "[t]he suggestion or motivation to combine references does not have to be stated expressly, rather it may be shown by reference to the prior art itself, to the nature of the problem solved by the invention, or to the knowledge of one of ordinary skill in the art". Medical Instrumentation and Diagnostics Corp. v. Elekta AB, 68 USPQ2d 1263 (Fed. Cir. 2003). Also see, *In re Nilssen* (CAFC) 7 USPQ2d 1500 (7/13/1988). "Nilssen urges this court to establish a "reality-based" definition whereby, in effect, references may not be combined to formulate obviousness rejections absent an express suggestion in one prior art reference to look to another specific reference. We reject that recommendation as contrary to our precedent which holds that for the purpose of combining references, those references need not explicitly suggest combining teachings, much less specific references." See, e.g., *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983); *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

"A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C 103(a)

(2000); *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1734, 82 USPQ2d 1285, 1391 (2007). “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” Id. 127 S. Ct. at 1739, 82 USPQ2d at 1395.

Also, “when a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one. If a person of ordinary skill in the art can implement a predictable variation, 103 likely bars patentability.” Id. 127 S. Ct. at 1740, USPQ2d at 1396.

“We have noted that evidence of a suggestion, teaching, or motivation to combine references may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *In re Dembiczak*, 50 USPQ2d 1614.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

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Application Number 	Application/Control No.	Applicant(s)/Patent under Reexamination
	10/815,637	LAPSTUN ET AL.
Examiner	Art Unit	
Ella Colbert	3696	